

### REMARKS

Claims 1–63 and 67 are pending. Claims 6, 10, 11, 13, 14, 26–30, 32–46, 49–53, 55–63, and 67 are withdrawn from consideration.

#### Amendments to the Claims

Claim 1 has been amended to recite in part “at least one *conformable* roller” and “the conformable roller is dimensioned and configured for forming a zero seal in the absence of an instrument extending therethrough, and *for contacting with and conforming to an instrument*, thereby forming an instrument seal in the presence of the instrument extending therethrough”.

Claim 15 has been amended to recite in part “the roller being sized and configured to form a zero seal in the absence of the instrument, and *to contact with and conform to the instrument*, thereby forming an instrument seal therewith in the presence of the instrument”.

Support for these amendments is found in the Specification and Drawings. *See, for example*, page 17, lines 6–8 (“With this configuration, the axle is slightly bendable or deformable along its length, thereby aiding in the ability of the roller 38 to conform to the shape of inserted instrument 30 such as the grasper.”), FIGS. 4A, 57–62.

Claims 24 and 47 have been amended to improve the grammar and for clarity. The scope of the claim has not been altered.

#### Rejections Under 35 U.S.C. § 102

Claims 1, 2, 4, 5, 7–9, 12, 15, 17, 18, 21, 22, 47, and 48 stand rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,360,417 (Gravener). “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co.*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987).

Claim 1 as amended recites in part “the *conformable* roller is dimensioned and configured for forming a zero seal in the absence of an instrument extending therethrough, and *for contacting with and conforming to an instrument*, thereby forming an instrument seal in the presence of the instrument extending therethrough.” The Examiner refers to FIGS. 22 and 23 as disclosing cylindrical pinching members 96 as corresponding to the recited roller. Gravener does not disclose that the pinching member 96 is conformable. Also, as illustrated in FIGS. 22 and 23

and described in Gravener, the pinching member **96** does not contact with or conform to an instrument extending through the cannula assembly **56**. Instead, an instrument extends through and contacts with a middle portion **28** disposed between a pair of pinching members **96**. Accordingly, Gravener does not anticipate claim 1 for at least this reason. Because claims 2, 4, 7-9, and 12 are dependent on claim 1 and recite additional features, Gravener also does not anticipate these claims for at least the same reason.

Claim 15 as amended recites in part a roller sized and configured "to contact with and conform to the instrument". As discussed above, Gravener does not disclose this feature. Accordingly, claim 15 and claims 17, 18, 21, and 22, which are dependent on claim 15, are also not anticipated by Gravener for at least the same reason.

Claim 47 recites in part "a roller valve ... including a compliant material". As discussed above, Gravener does not disclose the recited roller valve. Accordingly, claim 47 and claim 48, which is dependent on claim 47, are not anticipated by Gravener for at least this reason.

Gravener also does not suggest the features recited in independent claims 1, 15, and 47 and their dependent claims. Because the middle portion **28** forms the seal in Gravener, one skilled in the art would have no reason to modify the device **56**, either with a conformable pinching member **96** or to eliminate the middle portion **28**, thereby contacting the instrument with the pinching member **96**. Because Gravener does not disclose or suggest every feature recited in the claims, claims 1, 2, 4, 5, 7-9, 12, 15, 17, 18, 21, 22, 47, and 48 also are not obvious over Gravener.

### **Claim Rejections Under 35 U.S.C. § 103**

Obviousness is a question of law based on underlying factual inquiries set forth in *Graham v. John Deere*: (1) determining the scope and content of the prior art; (2) ascertaining the differences between the claimed invention and the prior art; and (3) resolving the level of ordinary skill in the pertinent art. Objective evidence of non-obviousness must be also considered. In assessing the differences between the claim and the cited references, every feature of the claim must be disclosed or suggested in the cited references or known to one skilled in the art in making a *prima facie* case of obviousness. A *prima facie* case of obviousness also requires a reasonable expectation of success in the modification or combination of references, which must

be found in the cited references or must be known to one skilled in the art. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Claims 3 and 23 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Gravener. Claim 3 is dependent on claim 1. Claim 23 is dependent on claim 15. As discussed above, Gravener does not disclose or suggest every feature recited in either claim 1 or claim 15. Accordingly, Gravener also does not disclose or suggest every feature recited in claim 3 or claim 23, and consequently, these claims are allowable over Gravener for at least this reason.

Claims 16, 19, 20, 24, 25, 31, and 54 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Gravener in view of U.S. Patent No. 6,238,373 (de la Torre). The Examiner relies on de la Torre only for disclosing a gel material. Claims 16, 19, and 20 are dependent on claim 15. Claim 54 is dependent on claim 47. As discussed above, Gravener does not disclose or suggest every feature recited in claims 15 and 47. Accordingly, Gravener and de la Torre do not in combination disclose or suggest every feature recited in claims 16, 19, 20, 31, and 54, and these claims are allowable over the cited references for at least this reason.

The Examiner states that it would have been obvious to include the gel material of de la Torre around the pinching member 96 of Gravener, “thereby providing a better seal between the valve and the instrument.” As discussed above, the pinching member 96 in Gravener does not contact the instrument and form a seal therewith. Accordingly, Examiner’s reason for combining the references is not supported by disclosures of the references themselves. Accordingly, the claims are allowable over the cited references for at least this reason.

Independent claim 24 recites in part a “resilient material is susceptible to tearing in response to an instrument inserted into the working channel”. de la Torre does not disclose or suggest the recited resilient material. In fact, tearing of the material when an instrument is inserted through the skin seal of de la Torre would push torn pieces of the material into the patient: an undesirable result. Accordingly, one skilled in the art would understand that such a material would be absolutely unsuitable in the skin seal of de la Torre. For at least this reason, claim 24 and claim 25, which is dependent on claim 24, are allowable over the cited references for at least this reason.

### **No Disclaimers or Disavowals**

Although the present paper may include a combination of alterations to the application or claims, or characterizations of claim scope or referenced art, Applicants are not conceding that previously pending claims in this application are not patentable over the cited references. Rather, any alterations and/or characterizations are made to facilitate prosecution of this application. Applicants reserve the right to pursue any previously pending, or other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or in any prior prosecution. Accordingly, reviewers of this or any parent, child, or related prosecution history shall not reasonably infer that Applicants have made any disclaimers or disavowals of any subject matter supported by the present application.

### **Conclusion**

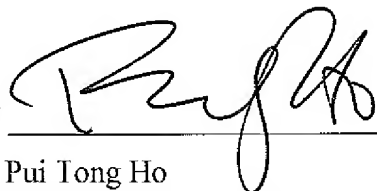
Applicants submit that all of the Examiner's rejections have been addressed and overcome, and that all claims are allowable over the art of record. Applicants have submitted amendments and arguments believed to be sufficient to overcome all of the outstanding rejections. Consequently, Applicants have not advanced every argument for the allowability of the claims over the references of record. As such, Applicants do not acquiesce to any of the Examiner's statements or characterizations not specifically traversed. Should the Examiner believe that any outstanding issues are resolvable in an Examiner's Amendment, the Examiner is invited to contact the undersigned.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No 01-2215.

Respectfully Submitted,

APPLIED MEDICAL RESOURCES

BY



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